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27. (New) The miter saw of Claim 1, wherein said first moveable fence is moveable to a position between said first fixed fence and said cutting tool.

02 28. (New) The miter saw of Claim 27 wherein said second moveable fence is moveable to a position between said second fixed fence and said cutting tool.

29. (New) The miter saw of Claim 22 wherein said moveable fence is moveable to a position between said first fixed fence and said saw blade.

#### **REMARKS**

Claims 1-7, 10, 11, 14, 15 and 22-29 remain pending in the present application. Claims 2-7 are currently withdrawn from consideration at this time.

#### **REJECTION UNDER 35 U.S.C. § 112**

Claims 1, 10, 11, 14, 15 and 22-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification has been amended to state that the structure which permits movement to both lateral sides of the saw is the same as the structure which permits movement to only one side of the saw except that any permanent stops which stop the saw at its vertical position have been eliminated. These structures which permit this dual movement capability are well known in the art. Thus, applicant believes this

statement regarding the structure and Figure 10 now supports the claimed movement of the saw. Reconsideration of the rejection is respectfully requested.

### **DOUBLE PATENTING**

Claims 1, 10, 11, 14, 15 and 22-26 are rejected under the judicially created doctrine of non-statutory double patenting over Claims 1-47 of U.S. Patent No. 5,297,463. Enclosed is an Associate Power of Attorney and a Terminal Disclaimer to overcome the double patenting rejection.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1, 10, 11, 14, 15 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Viazanko, Patent No. 4,798,113, in view of Brundage et al., Patent No. 4,934,233. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Viazanko, Patent No. 4,798,113, in view of Brundage as applied to Claim 22 above, and further in view of Novak, Patent No. 3,901,498. The Examiner is taking Viazanko (4,798,113) and replacing the miter saw in Viazanko with the saw illustrated in Meek et al. (1,646,589) or Elder (3,302,669). Applicant respectfully traverses these rejections by the Examiner. Meek et al. discloses a fixed fence cut away on both sides of the saw to provide clearance for the saw at bevel. This is the exact structure that the present invention improves by providing the moveable portion of the fence. Elder discloses a removable fence 50 located on both sides of the saw, but due to the radial arm configuration of the saw, having a fixed and a

moveable fence is impractical due to the interference it would cause with the use of the table during other cutting configurations.

It is respectfully submitted that the Examiner is using an improper approach to reject Applicants' claims. The law is clear that there must be some suggestion or incentive to use the construction defined in Applicants' claims. For example, the Court of Appeals for the Federal Circuit in ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 (Fed. Cir. 1984) stated:

Obviousness cannot be established by combining the teachings in the prior art to produce the claimed invention, absent same teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.

See also, In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984) where the court stated:

The mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.

It is submitted that the Examiner has failed to prove that there is some suggestion or teaching in the references that would provide the practitioner with a motivation to combine their respective teachings to arrive at Applicants' claimed invention.

In a recent decision of the C.A.F.C., Panduit Corp. v. Dennison Manufacturing Co., 810 F. 2d 1561, 1 U.S.P.Q. 2d 1593 (Fed. Cir. 1987), Chief Judge Markey discussed and applied various judicial pronouncements in reversing a lower court's holding of invalidity based on obviousness under Section 103, and further cautioned against the impermissible use of hindsight in picking and choosing isolated elements from various pieces of prior art, which bear little or no relationship to each other or to the problems addressed by the Applicants' invention, in reconstructing the

claimed invention from the Applicants' own disclosure.

In the Panduit decision, Chief Judge Markey offered the opinion that such impermissible hindsight reconstruction from isolated elements in a number of prior art references in order to arrive at the claimed combination is contrary to the purpose of the patent laws.

"Virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, Section 103.11 810 F. 2d at 1575, 1 U.S.P.Q. 2d at 1603.

Furthermore, Judge Markey severely criticized the lower court for failing to view the claimed combination invention as a whole, but rather selecting bits and pieces from prior patents that might be modified to fit the lower court's interpretation of the claims.

Further, in the Panduit decision, Judge Markey discussed the fact that the large body of prior art, individual pieces of which show various bits and pieces of the claimed combination, can actually support a conclusion of non-obviousness, rather than serving as a basis for hindsight bit-by-bit reconstruction of the claimed invention.

"Indeed, that the elements noted by the court lay about in the prior art available for years to all skilled workers, without, as the court found, suggesting anything like the claimed inventions, is itself evidence of non-obviousness. ... [The court] nowhere reconciled [its] evaluations with its contrary findings that no one skilled in the art had for years been led to those evaluations by the prior art." 810 F. 2d at 1577-78, 1 U.S.P.Q. 2d at 1605.

Judge Markey's opinion also addressed the hindsight picking and choosing problem accordingly:

"The district court nowhere pointed to anything in the prior art that would have suggested the desirability, and thus the obviousness, of making the distinctive structural elements and combinations... invented and claimed. Nor

did the court succeed in the difficult task of casting its mind back into that of a person of ordinary skill in the art that had no pre-knowledge of the crucial structural differences that vitalize [the] inventions." 810 F. 2d at 1580, 1 U.S.P.Q. 2d at 1606 (emphasis in the court's opinion).

Therefore, the combination of the cited references does not appear to teach or suggest Applicants' claimed invention, when considered as a whole, without resorting to the improper use of hindsight in combining referenced under Section 103 has repeatedly been judicially-held to be impermissible both by the C.C.P.A. and by the C.A.F.C. E.g., Panduit, supra; Carl Schenck, A.G. v. Nortron Corp., 713 F. 2d 782, 218 U.S. P.Q. 698 (Fed. Cir. 1983); In re Horn, supra; In re VanWanderham, 378 F. 2d 981, 154 U.S.P.Q. 20 (C.C.P.A. 1967); In re Cable, 347 F. 2d 872, 146 U.S.P.Q. 175 (C.C.P.A. 1965); In re Spork, 301 F. 2d 686, 133 U.S.P.Q. 360 (C. C.P.A. 1962); In re Mena and Driessen, supra; and In re Osplack; 195 F. 2d 921, 93 U.S.P.Q. 306 (C.C.P.A. 1952).

Thus, applicant believes Claims 1 and 22 patentably distinguish over the art of record. Likewise, Claims 10, 11, 14, 15 and 23-26 which ultimately depend from Claim 1 or Claim 2 are also believed to patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

### **REJOINDER OF CLAIMS**

Applicant respectfully requests the rejoinder of Claims 2-7.

### **NEW CLAIMS**

New Claims 27-29 are dependent claims which define the movable fence as being movable to a position between the fixed fence and the saw blade or cutting

tool. As disclosed in Viazanko column 6, line 15, "since the index holder 160 stops at the right end of fence 162...". Figure 13 illustrates an embodiment where fence 164 is allowed to move onto but not beyond fence 20. (The same can be said for fences 165 and 22). Thus, there is no teaching or suggestion in Viazanko, Elder or Meek to move the moveable fence to a position between the fixed fence and the saw as illustrated in Figures 1, 2, and 6 and claimed in Claims 27-29. Applicant believes new Claims 27-29 read on the elected invention of the present application.

### CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: MARCH 6, 2003

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## **ATTACHMENT FOR SPECIFICATION AMENDMENTS**

The following is a marked up version of each replacement paragraph and/or section of the specification in which underlines indicates insertions and brackets indicate deletions.

Please replace the paragraph beginning on Page 13, line 22 with the following new paragraph:

Figure 10 schematically illustrates the provision of a laterally adjustable moveable fence portion on each lateral side of an exemplary compound miter saw according to the invention. The structure which allows for this movement on each lateral side of the compound miter saw is the same as the structure which permits movement to one side only as illustrated in Figures 1-4 and 6, except that permanent stops which position saw blade 14 at its vertical position have been eliminated. These structures which permit movement on each lateral side of a compound miter saw are well known in the art. Such dual moveable fence provision accommodates movement to selective miter, bevel, and compound cutting operations on either lateral side of the compound miter saw. Similarly, such an arrangement is advantageous in other work-performing devices where work operations can be preformed on either lateral side of the device, as well as being capable of accommodating large working tools, such as large shaper cutters, for example.